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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/623,315	07/17/2003	Chih-Feng Lai	PUSA030504	3455
23595	7590	02/15/2006	EXAMINER	
NIKOLAI & MERSEREAU, P.A. 900 SECOND AVENUE SOUTH SUITE 820 MINNEAPOLIS, MN 55402			AFZALI, SARANG	
			ART UNIT	PAPER NUMBER
			3729	

DATE MAILED: 02/15/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No. 10/623,315	Applicant(s) LAI, CHIH-FENG	
	Examiner Sarang Afzali	Art Unit 3729	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 18 January 2006.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-4 is/are pending in the application.
- 4a) Of the above claim(s) 1, 3 and 4 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 2 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 7/17/2003 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Election/Restrictions

1. Applicant's election with traverse of Group II claims 11-14 in the reply filed on 1/18/2006 is acknowledged.

The traversal is on the ground(s) that according to the Applicant that even if the stationery clip could be manufactured by a materially different process, it will be necessary to search and examine the stationery clip of claims 3 and 4 in order to search and examine claim 2 as claim 2 is clearly the preferred method of manufacture the clip of claims 3 and 4.

This is not found persuasive because the two groups of inventions are indeed distinct from one another with Group I, Claims 1, drawn to a mold assembly, classified in class 83, subclass 687, Group II, Claim 2, drawn to a method of making stationary clips, classified in class 29, subclass 412, and Group III, claims 3-4, drawn to a stationary clip, classified in class 402, subclass 14.

The inventions are distinct, each from the other because of the following reasons:

Inventions I and III are related as apparatus and product made. The inventions in this relationship are distinct if either or both of the following can be shown: (1) that the apparatus as claimed is not an obvious apparatus for making the product and the apparatus can be used for making a different product or (2) that the product as claimed can be made by another and materially different apparatus (MPEP § 806.05(g)). In this case, the product as claimed can be made by another and materially different apparatus, such as by cutting using shears prior to forming the recess.

Inventions II and III are related as process of making and product made. The inventions are distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different product or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(F)). In the instant case, the product as claimed can be made by another and materially different process, such as one in which the clip is cut without using a mold prior to forming the recess.

Inventions II and I are related as process and apparatus for its practice. The practiced by another materially different apparatus or by hand, or (2) the apparatus as claimed can be used to practice another and materially different process. (MPEP § 806.05(e)). In this case, the process as claimed can be performed by hand.

Because these inventions are distinct for the reasons given above and have acquired a separate status in the art as shown by their different classification, restriction for examination purposes as indicated is proper.

The requirement is still deemed proper and is therefore made FINAL.

2. Claims 1 and 3-4 withdrawn from further consideration pursuant to 37 CFR 1.142(b), as being drawn to a nonelected invention, there being no allowable generic or linking claim. Applicant timely traversed the restriction (election) requirement in the reply filed on 1/18/2006.

Specification

3. The disclosure is objected to because of the following informalities:

Abstract, line 1, " ... upper molding devic ..." should read - - ... upper molding device ... - -.

Appropriate correction is required.

Claim Objections

1. Claim 2 is objected to because of the following informalities: Applicant needs to provide a cleaned and unmarked copy of the amended claim in response to this office action.

Appropriate correction is required.

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

2. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Ballard et al. (U.S. 6,430,799) in view of Alexander (U.S. 2,703,311). Ballard et al. teach a method of one piece metallic bulbshield in a form of a clip comprised of the following steps:

(a) disposing a metal plate (203, Fig. 7) on a first lower mold (first die block 211, Fig. 5) and engaging a first upper mold (first punch block 217, Fig. 5) with the first lower

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mold (first die block 211, Fig. 5) to punch (at station B, Fig. 7) the metal plate to form two wing strip (pair of legs 229, Fig. 7);

(b) disposing the metal plate (203, Fig. 7) on a second lower mold (second die block 211, Fig. 5) and engaging a second upper mold (second punch block 217, Fig. 5) with the second lower mold (second die block 211, Fig. 5) to punch (at station C, Fig. 7) the metal plate to form a basic main body (237) having a pair of connection parts each connected to the corresponding wing strip;

(c) disposing the metal plate on a third lower mold and engaging a third upper mold with the third lower mold to punch (at station E, Fig. 7) the metal plate to form an enlarged main body (237 and 239, Fig. 7) on the basic main body and the enlarged main body having a pair of connection portions each connected to the corresponding wing strip;

(d) disposing the metal plate on a fourth lower mold and engaging a fourth upper mold with the fourth lower mold to punch (at station F, Fig. 7) the metal plate and to fold the wing strips upward in parallel;

(e) disposing the metal plate on a fifth lower mold and engaging a fifth upper mold with the fifth lower mold to punch (at station G, Fig. 7) the metal plate and to form a tree-shaped recess (the shears 241 are considered tree shaped recesses, Fig. 7) on the enlarged main body;

(f) disposing the metal plate on a sixth lower mold and engaging a sixth upper mold with the sixth lower mold to punch (at station M, Fig. 7) the metal plate and to fold the wing strips toward each other;

- (g) disposing the metal plate on a seventh lower mold and engaging a seventh upper mold with the seventh lower mold to punch (at station N, Fig. 7) the metal plate and to fold the wing strips close to each other;
- (h) disposing the metal plate on an eight lower mold and engaging an eight upper mold with the eight lower mold to punch (at station S, Fig. 7) the metal plate and to form dent on the enlarged main body (bumped shoulder or swage 249 is considered a dent, Fig. 7); and
- (i) disposing the metal plate on a ninth lower mold and engaging a ninth upper mold with the ninth lower mold to cut an outer periphery of the enlarged main body to be disengaged from the metal plate to form a stationary clip (at station U, Fig. 7).

Ballard et al. teach the invention cited with the exception of the electroplating the metal plate. However, it is well known in the art to electroplate metallic plates and articles to produce colors for decorative purposes and to prevent rust and corrosion of the article such as one taught by Alexander wherein an improved electroplating solution is used to provided plating for having an improved luster and color (col.1, lines 15-23 & col. 2, lines 16-17). It would have been obvious to one of ordinary skill in the art at the time of invention to have provided Ballard et al. with an electroplated metal in order to have a add color and luster to the metal.

Conclusion

3. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

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Any inquiry concerning this communication or earlier communications from the examiner should be directed to Sarang Afzali whose telephone number is 571-272-8412. The examiner can normally be reached on 7:00-3:30 M-F.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Peter Vo can be reached on 571-272-4690. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

S.A.

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02/10/2006


MARC JIMENEZ
PRIMARY EXAMINER

2-13-03